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10/086,180

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Bruce L. Davis

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DIGIMARC CORPORATION
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EXAMINER

LAZARO, DAVID R

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE L. DAVIS

Appeal 2009-007031
Application 10/086,180¹
Technology Center 2400

Before JAMES D. THOMAS, THU A. DANG, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

C. THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL²

¹ Application filed February 25, 2002. The real party in interest is Digimarc Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-15, 27, 28, and 33, which are all the claims pending in the application, as claims 16-26, 29-32, and 34-36 are withdrawn. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

The present invention relates to private use of photos maintained in archives of State Departments of Motor Vehicles or the like. (Spec., 1:8-9.)

Claim 1 is illustrative:

1. A method of printing a trusted image, comprising:
an individual user electronically contacting a governmental agency, soliciting an image depicting the user stored in an archive maintained by said governmental agency;
electronically receiving said image from said contacted governmental agency; and printing a document incorporating said image.

Appellant appeals the following rejections:

1. Claims 1-3, 5, 10, 11, 27, and 33 under 35 U.S.C. § 103(a) as unpatentable over Dellert (US 5,760,916, June 2, 1998); and
2. Claims 4, 6-9, 12-15, and 28 under 35 U.S.C. § 103(a) as unpatentable over Dellert and Rhoads (US 5,841,886, Nov. 24, 1998).

FACTUAL FINDINGS

Dellert

1a. Dellert discloses a “method by which image signals corresponding to hardcopy photographs can be readily retrieved and distributed as desired by a user.” (Col. 1, ll. 7-9.)

1b. In Dellert, “hub station 20 may be set such that any image set signal received will be stored and indexed with its associated identification signal.” (Col. 9, ll. 13-15.)

1c. In Dellert, “such a system allows a user to consistently obtain further desired services, such as forwarding copies of the images to others or obtaining products incorporating the images, without regard to the location at which the images were scanned” (Col. 2, ll. 21-25.)

Rhoads

2. Rhoads discloses that “the present invention is a method of correlating, with a photograph, information about an individual whose image appears in the photograph.” (Col. 1, ll. 46-48.)

ANALYSIS

Claims 1, 2, 10, 11, 27, and 33

Issue 1: Did the Examiner err in finding that “contacting a government agency” is non-functional descriptive material, and Dellert discloses soliciting an image from an agency, as claimed in claim 1?

Appellant contends that “[n]othing in Dellert would have led an artisan to grant consumer access to a *governmental* image archive.” (App. Br. 8.) Appellant further contends that “[t]he Examiner disregarded

limitations expressed in the claim – asserting that language requiring a ‘governmental agency’ are entitled to *no* patentable weight.” (*Id.*)

The Examiner found “an agency maintaining the image archive as taught by Dellert would be the same as a governmental agency maintaining an image archive.” (Ans. 5.) We agree with the Examiner.

In essence, the Examiner found that Appellant’s claimed “governmental agency” is merely a label given to the agency providing the images, yet the claims do not show how the governmental agency affects the accessing or delivering of the images. We agree. Here, the distinction between where the image data comes from is not patentably consequential because it is a distinction grounded on nonfunctional descriptive material.

An Examiner must consider all claim limitations, including descriptive material, when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). However, the examiner need not give patentable weight to descriptive material that does not have a new and obvious functional relationship with the substrate (nonfunctional descriptive material). *See Gulack*, 703 F.2d at 1386; *see also In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004).

Here, there is no functional relationship between the governmental agency and the step of providing images. For example, Appellant has not shown how the “government agency” relates to and/or controls the request for and transmitting of images. Thus, the claimed feature reads on any “agency” providing images.

Dellert discloses a method for requesting and retrieving images, using a remote terminal, from an archive at a hub station (FF 1a-c.) Thus, the

claimed “maintained by a governmental agency” reads on Dellert’s hub station electronically providing stored images to a requesting user.

Thus, Appellant has not persuaded us of error in the Examiner’s conclusion of obviousness for representative claim 1. Appellant repeats the same argument made for claim 1 for claims 2, 10, 11, 27, and 33 (App. Br. 7-12). We will, therefore, treat claims 2, 10, 11, 27, and 33 as falling with claim 1. Therefore, we affirm the Examiner’s § 103 rejection of claims 1, 2, 10, 11, 27, and 33.

Claim 3

Issue 2: Did the Examiner err in finding that Dellert discloses that the document is a photo identification document?

Appellant contends “Dellert has *no* teaching of a photo identification document.” (App. Br. 9.)

The Examiner found that “[a] photograph is by nature an identification document of the image it is depicting. The claimed subject matter does not indicate any specific details or formatting required other than photo identification.” (Ans. 14.) We agree with the Examiner.

Claim 3 merely requires a “photo” identification document, as no further descriptive subject matter is set forth. As such, we agree that a photograph in and of itself represents a basic photo identification.

Furthermore, we find that providing the document as a photo identification document is merely a statement of intended use or purpose. An intended use of a claimed device does not limit the scope of the claim. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (product claim’s intended use recitations do not give patentable weight); *see also Boehringer*

Ingelheim Vetmedica, Inc. v. Schering-Plough Corp., 320 F.3d 1339, 1345 (Fed. Cir. 2003) (“An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.”). Here, Appellant’s purpose of printing an identification document merely defines an intended use of the retrieved image.

Claim 3 was argued separately (App. Br. 9-10). Thus, Appellant has not persuaded us of error in the Examiner’s conclusion of obviousness for representative claim 3. Therefore, we affirm the Examiner’s § 103 rejection of claim 3.

Claim 5

Issue 3: Did the Examiner err in finding that using “a motor vehicle licensing agency” and “a driver license photo” amounts to using nonfunctional descriptive material?

Appellant contends that “such terms are integrally, and functionally, involved in the recited acts.” (App. Br. 11.)

The Examiner found that “appellant’s own remarks indicating that an artisan would recognize that the image archive is the same regardless of the maintaining entity (i.e., there is no functional difference)” is evidence of obviousness. (Ans. 13.) We agree with the Examiner.

As noted above regarding claim 1, and equally applied here, the Examiner need not give patentable weight to descriptive material that does not have a new and obvious functional relationship with the substrate. Here, the “motor vehicle agency” and the “driver license photo” do not have a

functional relationship with the “electronically contacting,” “electronically receiving,” and “printing” elements of the claim.

Claim 5 was argued separately (App. Br. 10-12). Thus, Appellant has not persuaded us of error in the Examiner’s conclusion of obviousness for claim 5. Therefore, we affirm the Examiner’s § 103 rejection of claim 5.

Claims 4, 6-9, 12-15, and 28

Issue 4: Did the Examiner err in combining Dellert and Rhoads?

Appellant contends that “the rejection is silent as to why such teaching would have been combined with Dellert’s online photo ordering method. The rejection makes an unexplained leap. It lacks the ‘articulated reasoning with some rationale underpinning’ required by *KSR*.” (App. Br. 13.)

The Examiner found:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said document is an identification badge. One would be motivated to have this as identification badges are desirable and widely used for identification purposes.

(Ans. 8) (citation omitted.)

Here, the Examiner articulates that identification badges are desirable and widely used, as shown in Rhoads (*see* Ans. 8). We add that Dellert is concerned with using electronic images to form products incorporating the images (FF 1c) and Rhoads is similarly concerned with correlating a photograph with information about the individual whose image appears in the photograph (FF 2). As such, both cited references are concerned with

incorporating photographs into other products. Thus, we find that there is not an “unexplained leap” from Dellert’s system to Rhoads identification badge.

The Supreme Court has held that in analyzing the obviousness of combining elements, a court need not find specific teachings, but rather may consider “the background knowledge possessed by a person having ordinary skill in the art” and “the inferences and creative steps that a person of ordinary skill in the art would employ.” *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions,” and the basis for an obviousness rejection must include an “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id* at 417, 418.

Here, we find that the Examiner’s articulated reason noted *supra* sufficiently shows some rational underpinning given that both Dellert and Rhoads are concerned with incorporating images into products.

For claims 6-9, 12-15, and 28, Appellant essentially repeats the same argument made for claim 4. We will, therefore, treat claims 6-9, 12-15, and 28 as falling with claim 4 (App. Br. 13-15). Based on the record before us, we find that the Examiner did not err in rejecting claims 4, 6-9, 12-15, and 28. Accordingly, we affirm the rejections of claims 4, 6-9, 12-15, and 28.

DECISION

We affirm the Examiner’s § 103 rejections.

Appeal 2009-007031
Application 10/086,180

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

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